

REMARKS

This responds to the Final Office Action mailed on July 9, 2007.

Claim 16 is amended, no claims are canceled, and no claims are added; as a result, claims 16-20 are now pending in this application.

§102 Rejection of the Claims

Claims 16-19 were rejected under 35 U.S.C. § 102(e) for anticipation by Hu et al. (U.S. 7,197,465, hereinafter “Hu”). Applicants respectfully traverse the rejection for the reasons stated below.

Applicants respectfully submit that the Final Office Action did not make out a *prima facie* case of anticipation at least because Hu does not teach each and every claim element.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference¹

Claim 16, as amended, includes, in part, the limitations of:

“...generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered by the sender; and receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label.”
(Emphasis added)

In reviewing the portions of Hu relied upon by the Final Office Action (Hu, Fig. 12) it can be seen that Hu does not teach the amended claim 16 limitation of “*generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered by the sender.*”

Hu, states² that the User’s information, in Fig. 12, is provided by the User and no shipping information is automatically entered.:

FIG. 12 is a graphic representation depicting an exemplary embodiment of a User address collection screen. As depicted in FIG. 12, the System prompts the User to

¹ Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² Hu, at col. 15, lines 30-49

provide the User's name 106 As with the previous registration introduction screen 41, the Next 102, Reset 103, Cancel 104, and Help 105 buttons are provided with results similar in nature to the operations of these respective buttons as described above. In addition, a Back button 117 is provided. If the User clicks the Back button 117, the System returns the User to the screen from which the User entered the present screen If the User clicks the Next button 102, the System performs validation edits on the data entered. If any required fields have not been completed, or if any fields contain data found to be in error, the System notifies the User and requests that corrected data be entered.³ (Emphasis added)

In the cited passage, Hu's system prompts the User to provide information and if any required fields have not been completed, or if any fields contain data found to be in error, the System notifies the User and requests that corrected data be entered. However, the system in Hu does not teach *shipping information pertaining to the shipment may be automatically entered*, as required by the amended claim 16. Thus, User's information, in Fig. 12, is provided by the User and no shipping information is automatically entered. Accordingly, Hu fails to disclose the limitation of "*generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered by the sender,*" as recited in the amended claim 16.

In the Advisory Action mailed September 10, 2007, the Examiner continued to reject claim 16 on the grounds that because Hu provides shipping data "manually entered" by sender, the claim could be given its broadest reasonable interpretation. The proposed amendment to claim 16 removes the "manually entered" feature. Neither the Office Action nor the Advisory Action contain any interpretation of Hu as showing or suggesting automatically providing the shipping data. In the Advisory Action, the Examiner referred in passing to automatically providing shipping data, by merely asserting "...examiner does not admit the absence of this feature..." Applicants are unable to find the feature in Hu.

The Final Office Action has also relied on Fig. 25 of Hu to reject claim 16 which includes a limitation of "*receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label.*" As described by the following passage, Fig. 25 does not teach this limitation. Hu, in Col. 19, lines 6-14 states:

FIG. 25 is a graphic representation of an exemplary embodiment of a Create a Seller's Link Screen 52. Before the System can create a Seller's link, the User must tell the System information about the particular package that will be

³ Hu, col. 6, lines 30-49

shipped. Accordingly, as depicted in FIG. 25, the System asks the User to enter the shipping weight and value of the item to be shipped 190. The User is asked to enter the Shipping Weight 191a.⁴
(Emphasis added)

According to the above cited passage from Hu, Fig. 25 is a Create a Seller Link Screen, where the User must tell the system information about the package. For example the system asks the User to enter the shipping weight and value of the item to be shipped. However, asking the User to enter the shipping weight and . . . is not the same as *receiving shipping data pertaining to the shipment from the shipping vendor*, specifically, the User in the context of the Create a Seller's Link is not the same as the claimed *shipping vendor* (see Hu, col. 18, lines 11-12, where it is stated “. . . User's client machine (Seller's computer) . . .”, that is to say, User is defined to be Seller). Thus, Hu's Fig. 25 fails to teach the limitation of “*receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label*,” as recited in claim 16.

Therefore, at least for the reasons set forth above, Hu fails to teach each and every element of claim 16, as amended. As such, Applicants respectfully submit that rejection under 102(e) of independent claim 16 and its dependent claims 17-20 over Hu has been overcome. Thus, it is requested the claim rejections under 35 U.S.C. § 102(e) be reconsidered, in light of the claim amendment, and be withdrawn.

§103 Rejection of the Claims

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hu et al. in view of Official Notice.

In consideration of the above 35 U.S.C. § 103(a) rejection, in light of the arguments presented above with respect to claim 16, Hu fails to anticipate the independent claim 16, and therefore also does not disclose the subject matter of dependent claim 20 which adds additional limitations to claim 16. Although the Examiner took Official Notice that “the creation of a virtual credit card for use in payment for products or services was old and well known in the art at the time of the invention,” those findings do not anticipate those elements of claim 16 which

⁴ Hu, col. 19, lines 6-14

are missing from Hu. Thus claim 20, as a dependent claim from allowable amended claim 16, is distinguishable from the cited patent and the facts of which Official Notice was taken.

Therefore, Applicants respectfully submit, in view of the amendment of claim 16, for the reasons stated above, that there is no *prima facie* showing of obviousness of claim 20. It is respectfully requested the claim rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully submit that all of the claims are now in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at 408-278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Final Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/749,682

Filing Date: December 31, 2003

Title: METHOD AND SYSTEM FOR FACILITATING SHIPPING VIA A THIRD PARTY PAYMENT SERVICE

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Dkt: 2043.035US2

Respectfully submitted,

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Date October 8, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of October 2007.

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Signature